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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,897	11/28/2000	Gustave Bergnes	CYTOP009C5	1088

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BEYER WEAVER & THOMAS LLP
P.O. BOX 778
BERKELEY, CA 94704-0778

EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 07/11/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/724,897

Applicant(s)

BERGNES ET AL.

Examin r

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 31, 50 and 60-77 is/are pending in the application.
- 4a) Of the above claim(s) 61-63 and 65-67 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 72-77 is/are allowed.
- 6) ☒ Claim(s) 31, 50, and 68-71 is/are rejected.
- 7) ☒ Claim(s) 60 and 64 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11, 14, 19, 206 6) ☐ Other:

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FINAL ACTION

Applicant's amendment of 4-21-03 has been considered. The amended claim 31 has overcome the "New Matter" rejection. Applicant's argument has also overcome the 102 and 103 rejections based on **Chenard et. al.** However, the amended claims have prompted the following new ground of rejections.

Claims 61-63 and 65-67 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The compositions recited in said claims comprise an additional active ingredient, and thus require additional search.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 61-63, and 65-67 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 31, 50, 60, 64, and 68-77 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 31, 50, and 68-71 are rejected under 35 U.S.C. 102(e) as being anticipated by the following references:

a. **Schall et. al.** (US 6,559,160): On column 22, Schall et. al. discloses compound e (a racemate) which falls within the scope of the above claims when the claimed formula has the following substituents:

- i. R_1 is a substituted phenyl;
- ii. R_2' is hydrogen while R_2 is lower alkyl;
- iii. R_4 represents R_{16} -alkylene-, with R_{16} as dialkylamino group;
- iv. R_5 - R_8 are hydrogen.

b. **Baxter et. al.** (US 6,545,005): On columns 73 and 74, Baxter et. al. disclose an intermediate (compound #10 – a racemate) which falls within the scope of claim 50 when the claimed formula has the following substituents:

- v. R_1 is a substituted phenyl;
- vi. R_2' is hydrogen while R_2 is lower alkyl;

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vii. R_4 represents a lower alkyl group;

viii. R_5 - R_8 are hydrogen.

Because the instant claims do not recite a limitation of purity for the R-configuration, the disclosed compounds (or racemates) read on the claimed compounds. See *In re Adamson et. al.* (CCPA 1960) 275 F 2d 952, 125 USPQ 233 regarding optically active isomer that is unpatentable over a prior art racemate.

Claim Objections

2. Claims 60 and 64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Because the disclosed compounds are intermediates they do not read on the composition claims 60 and 64.

Allowable Subject Matter

3. Claims 72-77 are allowed. The prior arts of record do not read on the compounds recited in said claims.

Information Disclosure Statement

4. The IDS of 9-30-02 and 4-21-03 cite the "Registry File Compounds from Unspecified Chemical Libraries". Said citation is improper for not having **author** and **date**. Without said information, one cannot determine if such a document is a competent prior art, or if the listed

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compounds has been made by others. Therefore, applicant is required to submit such information.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9:30-5:00) & every Saturday morning (starting from 4-7-03).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

T. Truong

July 9, 2003



BRUCK KIFLE, PH.D.
PRIMARY EXAMINER